UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,851	06/20/2001	Alan Brett Conley	50325-0553	6237

29989 7590 01/09/2004		EXAMINER
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SAN JOSE, CA 95125	ART UNIT	PAPER NUMBER
	2171	

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/886,851	CONLEY ET AL.
	Examiner	Art Unit
	Etienne P LeRoux	2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 November 2003</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>13-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>13-23</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>20 June 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Pub No

2002/0065941 issued to Kaan et al (hereafter Kaan '941).

Regarding claim 13, Kaan '941 discloses:

reading preprocessing information, the preprocessing information including override

information for nullifying information associated with one or more sites or one or more site links

from one or more router configuration files [paragraph 0038]

reading router interface information from a router configuration file associated with each

of one or more routers, wherein one or more site references is generated by identifying a sub-

network on a Local Area Network (LAN) [Fig 1, 130] interface and one or more site link

references by identifying a Wide Area Network (WAN) [Fig 1, 110] interface

wherein the override information is applied to the site and site link references [Fig 1, 100]

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaan '941

Regarding claim 14, Kaan '941 discloses generating a router name [paragraph 0078] but

does not disclose generating a name exception. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify Kaan '941 to include generating a

name exception for the purpose of determining a change in names.

5.   Claims 15-17, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kaan '941 as applied to claim 14 above, and further in view of US Pat No 4,853,843 issued to

Ecklund (hereafter Ecklund '843)

Regarding claims 15 and 16, Kaan '941 discloses the essential elements of the claimed

invention as noted above except for a temporary site name. Ecklund '843 discloses a temporary

site name. It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify Kaan '941 to include a temporary site name as taught by Ecklund '843 for

the purpose of processing requests when failures occur [col 16, line 14]

Regarding claim 17, the combination of Kaan '941 and Ecklund '843 disclose the

essential elements of the claimed invention as noted above except for generating a sub-network

with the temporary site name. It would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify the combination of Kaan '941 and Ecklund '843 to

include a sub-network with a temporary name for then purpose of creating a LAN [refer abstract

of Kaan '843].

Regarding claims 20 and 23, Kaan '941 discloses the essential elements of the claimed

invention as noted above except for merging one or more temporary site names and associated

partial site links, site links, sub-network references, and router names into one or more newly

created complete site names, and deleting from processing the one or more temporary site names

merged into the one or more newly created completed site names, thereby reducing the quantity

of temporary site names and increasing the quantity of site references associated with one or

more temporary site names. Ecklund '843 discloses merging one or more temporary site names

and associated partial site links, site links, sub-network references, and router names into one or

more newly crated complete site names, and deleting from processing the one or more temporary

site names merged into the one or more newly created completed site names, thereby reducing

the quantity of temporary site names and increasing the quantity of site references associated

with one or more temporary site names [Fig 10]. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify Kaan '941 to include merging one or

more temporary site names and associated partial site links, site links, sub-network references,

and router names into one or more newly crated complete site names, and deleting from

processing the one or more temporary site names merged into the one or more newly created

completed site names, thereby reducing the quantity of temporary site names and increasing the

quantity of site references associated with one or more temporary site names as taught by

Ecklund '843 for the purpose of merging virtual partitions in a distributed data base system [col 1, lines 5-10].

6.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaan '941 as applied to claim 13 and further in view of in view of US Pat No 5,968,121 issued to Logan et al (hereafter Logan '121)

Regarding claim 18, Kaan '941 discloses the essential elements of the claimed invention as noted above except for:

reading a list of one or more site names from a data storage associated with a network management system

reading from the data storage a list of one or more preprocessing site links and associated site link costs

comparing one or more site names parsed from one or more preprocessing site links to the list of one or more site names from the data storage and discarding one or more preprocessing site links upon failure to match

reading from the data storage a list of one or more preprocessing address blocks and at least one from a set consisting of a preprocessing site name associated with the one or more preprocessing address blocks or a command to ignore the one or more preprocessing address blocks

comparing the preprocessing site name associated with the one or more preprocessing address blocks to the list of one or more site names from the data storage and discarding one or more preprocessing address blocks upon a failure to match

reading a list of one or more domain controllers from the data storage and associating the one or

more domain controllers to an Internet Protocol address and to a site name obtained from a

network management system

determining a domain associated with the one or more domain controllers

comparing the Internet Protocol address for each of the listed domain controllers to the list of one

or more preprocessing address blocks

whereupon the step of reading preprocessing information aborts if the Internet Protocol address

is within one or more preprocessing address blocks and the preprocessing site name associated

with the one or more preprocessing address blocks is not the same as the site name obtained from

the network management system that is associated with the one or more domain controllers

whereupon the step of reading preprocessing information continues excluding the one or more

domain controllers from further processing if the Internet Protocol address is within one or more

preprocessing address blocks associated with the command to ignore the one or more

preprocessing address blocks. Logan '121 discloses reading a list of one or more site names

from a data storage associated with a network management system

reading from the data storage a list of one or more preprocessing site links and associated site

link costs

comparing one or more site names parsed from one or more preprocessing site links to the list of

one or more site names from the data storage and discarding one or more preprocessing site links

upon failure to match

reading from the data storage a list of one or more preprocessing address blocks and at least one

from a set consisting of a preprocessing site name associated with the one or more preprocessing

address blocks or a command to ignore the one or more preprocessing address blocks

comparing the preprocessing site name associated with the one or more preprocessing address

blocks to the list of one or more site names from the data storage and discarding one or more

preprocessing address blocks upon a failure to match

reading a list of one or more domain controllers from the data storage and associating the one or

more domain controllers to an Internet Protocol address and to a site name obtained from a

network management system

determining a domain associated with the one or more domain controllers

comparing the Internet Protocol address for each of the listed domain controllers to the list of one

or more preprocessing address blocks

whereupon the step of reading preprocessing information aborts if the Internet Protocol address

is within one or more preprocessing address blocks and the preprocessing site name associated

with the one or more preprocessing address blocks is not the same as the site name obtained from

the network management system that is associated with the one or more domain controllers

whereupon the step of reading preprocessing information continues excluding the one or more

domain controllers from further processing if the Internet Protocol address is within one or more

preprocessing address blocks associated with the command to ignore the one or more

preprocessing address blocks [col 16, lines 1-28.] It would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify Kaan '941 to include reading a list

of one or more site names from a data storage associated with a network management system

reading from the data storage a list of one or more preprocessing site links and associated site

link costs

comparing one or more site names parsed from one or more preprocessing site links to the list of

one or more site names from the data storage and discarding one or more preprocessing site links

upon failure to match

reading from the data storage a list of one or more preprocessing address blocks and at least one

from a set consisting of a preprocessing site name associated with the one or more preprocessing

address blocks or a command to ignore the one or more preprocessing address blocks

comparing the preprocessing site name associated with the one or more preprocessing address

blocks to the list of one or more site names from the data storage and discarding one or more

preprocessing address blocks upon a failure to match

reading a list of one or more domain controllers from the data storage and associating the one or

more domain controllers to an Internet Protocol address and to a site name obtained from a

network management system

determining a domain associated with the one or more domain controllers

comparing the Internet Protocol address for each of the listed domain controllers to the list of one

or more preprocessing address blocks

whereupon the step of reading preprocessing information aborts if the Internet Protocol address

is within one or more preprocessing address blocks and the preprocessing site name associated

with the one or more preprocessing address blocks is not the same as the site name obtained from

the network management system that is associated with the one or more domain controllers

whereupon the step of reading preprocessing information continues excluding the one or more

domain controllers from further processing if the Internet Protocol address is within one or more

preprocessing address blocks associated with the command to ignore the one or more

preprocessing address blocks as taught by Logan '121 for the purpose of automating network

directory services [col 2, lines 40-45]

7.   Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination

of Kaan '941 and Logan '121 as applied to claim 18, and further in view of US Pat No

5,850,526 issued to Chou (hereafter Chou '526).

        Regarding claim 19, Kaan '941 discloses the essential elements of the claimed invention

as noted above except for comparing an address of each of the one or more site references, one

or more site link references, and one or more sub-network references to the one or more

preprocessing address blocks

deleting from processing the one or more site references, the one or more site link references,

and the one or more sub-network references having an address being a subset or superset of the

one or more preprocessing address blocks and deleting from processing the partial site link

associated with discontinued one or more site link references

and if the temporary site name contains no site references, deleting from processing the

temporary site name and associated one or more router names, partial site links, site link

references, and sub-network references.

Chou '526 discloses comparing an address of each of the one or more site references, one or

more site link references, and one or more sub-network references to the one or more

preprocessing address blocks

deleting from processing the one or more site references, the one or more site link references,

and the one or more sub-network references having an address being a subset or superset of the

one or more preprocessing address blocks and deleting from processing the partial site link

associated with discontinued one or more site link references

and if the temporary site name contains no site references, deleting from processing the

temporary site name and associated one or more router names, partial site links, site link

references, and sub-network references [claim 1]. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify Kaan '941 to include comparing an

address of each of the one or more site references, one or more site link references, and one or

more sub-network references to the one or more preprocessing address blocks

deleting from processing the one or more site references, the one or more site link references,

and the one or more sub-network references having an address being a subset or superset of the

one or more preprocessing address blocks and deleting from processing the partial site link

associated with discontinued one or more site link references

and if the temporary site name contains no site references, deleting from processing the

temporary site name and associated one or more router names, partial site links, site link

references, and sub-network references as taught by Chou '526 for the purpose compressing data

on a network having arbitrary LAN stations [col 3, lines 45-50]

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination

of Kaan '941 and Logan '121 as applied to claim 18 and further in view of US Pat No

6,442,602 issued to Choudhry (hereafter Choudhry '602).

Regarding claim 21, Kaan '941 discloses the essential elements of the claimed invention

as noted above except for processing the one or more sub-network references to ensure that sub-

network references are not duplicated, processing the one or more sub-network references to

ensure that the network site information is minimized, and merging the one or more sub-network

references associated with one or more temporary site names into the one or more site references

associated with the same one or more temporary site names. Choudhry '602 discloses

processing the one or more sub-network references to ensure that sub-network references are not

duplicated, processing the one or more sub-network references to ensure that the network site

information is minimized, and merging the one or more sub-network references associated with

one or more temporary site names into the one or more site references associated with the same

one or more temporary site names [col 7, lines 15-45]. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Kaan '941 to include

processing the one or more sub-network references to ensure that sub-network references are not

duplicated, processing the one or more sub-network references to ensure that the network site

information is minimized, and merging the one or more sub-network references associated with

one or more temporary site names into the one or more site references associated with the same

one or more temporary site names as taught by Choudhry '602 for the purpose of quickly and

efficiently creating and managing subdomain names [col 4, lines 30-31]

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination

of Kaan '941 and Logan '121 as applied to claim 18 and further in view of US Pat No 5,872,786

issued to Shobatake (hereafter Shobatake '786).

Regarding claim 22, Kaan '941 discloses the essential elements of the claimed invention

as noted above except for generating a site link between one or more temporary site names,

comprising the steps of processing each partial link associated with each of the one or more

temporary site names to generate a valid site link based on matching a first partial site link

associated with a first temporary site name with only a second partial site link associated with a

second temporary site name, reading a list of one or more site links to determine if an existing

site link between the first temporary site name and the second temporary site name exists, upon

existence of an existing site link, comparing a bandwidth of the existing site link to a bandwidth

of the valid site link, upon the bandwidths being equal, summing the bandwidths to create a

summed bandwidth and associating the summed bandwidth with the existing site link and

discarding the valid site link, upon the bandwidths being unequal, maintaining the existing or

valid full site link with a larger bandwidth and discarding the other of the existing or valid full

site link, upon existence of the existing full site link, generating a valid site link between the first

temporary site name and the second temporary site name, the valid site link including a first

partial link associated with the first temporary site name and a second partial site link associated

with the second temporary site name comparing the bandwidth of the first partial site link to the

bandwidth of the second partial site link and upon the bandwidths being equal, generating a first

link cost based on the equal bandwidth and associating the first site link cost with the valid site

link, upon the bandwidths being unequal, generating a second site link cost based on the smaller

bandwidth and associating the second site link cost with the valid site link. Shobatake '786

discloses generating a site link between one or more temporary site names, comprising the steps

of processing each partial link associated with each of the one or more temporary site names to

generate a valid site link based on matching a first partial site link associated with a first

temporary site name with only a second partial site link associated with a second temporary site

name, reading a list of one or more site links to determine if an existing site link between the first

temporary site name and the second temporary site name exists, upon existence of an existing

site link, comparing a bandwidth of the existing site link to a bandwidth of the valid site link,

upon the bandwidths being equal, summing the bandwidths to create a summed bandwidth and

associating the summed bandwidth with the existing site link and discarding the valid site link,

upon the bandwidths being unequal, maintaining the existing or valid full site link with a larger

bandwidth and discarding the other of the existing or valid full site link, upon existence of the

existing full site link, generating a valid site link between the first temporary site name and the

second temporary site name, the valid site link including a first partial link associated with the

first temporary site name and a second partial site link associated with the second temporary site

name comparing the bandwidth of the first partial site link to the bandwidth of the second partial

site link and upon the bandwidths being equal, generating a first link cost based on the equal

bandwidth and associating the first site link cost with the valid site link, upon the bandwidths

being unequal, generating a second site link cost based on the smaller bandwidth and associating

the second site link cost with the valid site link [col 15, line 62 through col 16, line 8]. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Kaan '941 to include generating a site link between one or more temporary site names,

comprising the steps of processing each partial link associated with each of the one or more

temporary site names to generate a valid site link based on matching a first partial site link

associated with a first temporary site name with only a second partial site link associated with a

second temporary site name, reading a list of one or more site links to determine if an existing

site link between the first temporary site name and the second temporary site name exists, upon

existence of an existing site link, comparing a bandwidth of the existing site link to a bandwidth

of the valid site link, upon the bandwidths being equal, summing the bandwidths to create a

summed bandwidth and associating the summed bandwidth with the existing site link and

discarding the valid site link, upon the bandwidths being unequal, maintaining the existing or

valid full site link with a larger bandwidth and discarding the other of the existing or valid full

site link, upon existence of the existing full site link, generating a valid site link between the first

temporary site name and the second temporary site name, the valid site link including a first

partial link associated with the first temporary site name and a second partial site link associated

with the second temporary site name comparing the bandwidth of the first partial site link to the

bandwidth of the second partial site link and upon the bandwidths being equal, generating a first

link cost based on the equal bandwidth and associating the first site link cost with the valid site

link, upon the bandwidths being unequal, generating a second site link cost based on the smaller

bandwidth and associating the second site link cost with the valid site link as taught by

Shobatake '786 for the purpose of increasing process migration without increasing a system cost

[col 6, lines 5-15]

Response to Arguments

Applicant's arguments filed 11/3/2003, have been fully considered but they are not

persuasive.

First Applicant Argument:

Applicant states on page 17, "Kaan in no way teaches, suggests or motivates the features

that are recited in Claim 13. The citation of Kaan that allegedly anticipates Claim 13 refers to a

system for managing a network, and does not even remotely teach, either directly, implicitly or

inherently, the method of automatically generating network site and site link information from a

router configuration file for use in a directory service that is recited in Claim 13. Therefore, it

cannot and does not anticipate Claim 13, and the remainder of the cited references do not cure

this deficiency of Kaan.

First Examiner Response:

Examiner is not persuaded. It is expedient to refer to instant specification to obtain a

definition of directory service. Applicant's specification, paragraph 11 states "The network

topology created by generating site and site link references is known as the Active Directory

replication topology and is stored in the directory." Kaan discloses the following in paragraphs

41 and 42:

[0041] According to another configuring aspect, the host 120 has a processor 126 and a storage
unit 124 with a UCCD Manager software program 122 stored thereon. This UCCD Manager
software 122 has instructions which the host 120 uses to initiate a connection through a network
interface device 150 to the WAN 110. The UCCD Manager program 122 also has instructions
that operate with the processor 126 to further configure the router 115. That is, besides the router
115 being configured by the configuration file 116 to be recognizable by the host, etc., as was
described above, the router is also configurable from the host 120, via the UCCD Manager
program 122, to properly to communicate with the WAN 110. That is, it was described above
that the router 115 is **automatically configured** by the bootable configuration file 116 for
recognition by the mobile unit host 120, but in an alternative embodiment, the router 115 is

configured by the UCCD Manager program 122 instead of, or in addition to the router 115 booting a configuration file 116.

[0042] The UCCD Manager program 122 provides a set of menus and windows for the user to select the type of connection to be made. The UCCD manager has a point and click user interface that is installed via a conventional CDROM using the industry standard "setup.exe" installation procedure. Once the connection type is specified and the user clicks "connect," the user can then observe the **UCCD Manager program 122 do the following**: configure the router 115 appropriately, instruct the router 115 to make the connection, test each step as the connection progresses, and finally test data transmission over the newly established link. If anything goes wrong during the connection setup, messages and dialog boxes appear to help the user diagnose the problem.

Examiner maintains that Kaan reads on the claimed "method of automatically generating

network site and site link information from a router configuration file for use in a directory

service" that is recited in Claim 13.

Second Applicant Argument:

Applicant states on page 18, "Furthermore, in view of the Declaration described above, it

is respectfully requested that Kaan be removed as a prior art reference on which the rejection of

Claim 13 relies.

Second Examiner Response:

Examiner is not persuaded for reasons given below.

Affidavit or Declaration Under 37 CFR 1.131: Ineffective

The affidavit filed on 11/3/2003, under 37 CFR 1.131 has been considered but is

ineffective to overcome the Kaan reference for reasons given below.

Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of

Conception

The evidence submitted is insufficient to establish a conception of the invention prior to

the effective date January 5, 2001, of reference document Pub. No. 2002/0065941 issued to

Kaan. While conception is the mental part of the inventive act, it must be capable of proof, such

as by demonstrative evidence or by a complete disclosure to another. Conception is more than a

vague idea of how to solve a problem. The requisite means themselves and their interaction

must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C.

Cir. 1897).

Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Reduction

to Practice

The evidence submitted is insufficient to establish a reduction to practice of the invention

in this country or a NAFTA or WTO member country prior to the effective date of January 5,

2001, of reference document Pub. No. 2002/0065941 issued to Kaan.

Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Diligence Lacking

The evidence submitted is insufficient to establish diligence from a date prior to the date

of reduction to practice of the Kaan reference to either a constructive reduction to practice or an

actual reduction to practice for the reasons given below.

Formal Requirements of Affidavits and Declarations:

It is expedient to consider the formal requirements of affidavits and declarations as presented in

the MPEP.

The following definition of conception is taken from MPEP § 2138.04:

> Conception has been defined as "the complete performance of the mental part of the
> inventive act" and it is "the formation in the mind of the inventor of a definite and permanent
> idea of the complete and operative invention as it is thereafter to be applied in practice...."
> Townsend v. Smith, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is
> established when the invention is made sufficiently clear to enable one skilled in the art to reduce
> it to practice without the exercise of extensive experimentation or the exercise of inventive skill."
> Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as
> a disclosure of an invention which enables one skilled in the art to reduce the invention to a
> practical form without "exercise of the inventive faculty." Gunter v. Stream, 573 F.2d 77,
> 197 USPQ 482 (CCPA 1978). See also Coleman v. Dines, 754 F.2d 353, 224 USPQ 857 (Fed.
> Cir. 1985) (It is settled that in establishing conception a party must show possession of every
> feature recited in the count, and that every limitation of the count must have been known to the
> inventor at the time of the alleged conception. Conception must be proved by corroborating
> evidence.); Hybritech Inc. v. Monoclonal Antibodies Inc., 802 F. 2d 1367, 1376, 231 USPQ 81,
> 87 (Fed. Cir. 1986) (Conception is the "formation in the mind of the inventor, of a definite and
> permanent idea of the complete and operative invention, as it is hereafter to be applied in
> practice."); Hitzeman v. Rutter, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001)

The following definition of reduction to practice is taken from MPEP § 2138.05:

> "The nature of testing which is required to establish a reduction to practice depends on
> the particular facts of each case, especially the nature of the invention." Gellert v. Wanberg, 495
> F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) ("an invention may be tested sufficiently ...
> where less than all of the conditions of actual use are duplicated by the tests"); Wells v. Fremont,
> 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) ("even where tests are conducted under bench' or
> laboratory conditions, those conditions must fully duplicate each and every condition of actual
> use' or if they do not, then the evidence must establish a relationship between the subject matter,
> the test condition and the intended functional setting of the invention," but it is not required that
> all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion
> in water).

The following regarding facts and documentary evidence is taken from MPEP § 715.07:

> A general allegation that the invention was completed prior to the date of the reference is

not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883).
Similarly, a declaration by the inventor to the effect that his or her invention was
conceived or reduced to practice prior to the reference date, without a statement of facts
demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies
thereof, accompany and form part of the affidavit or declaration or their absence
satisfactorily explained. In Ex parte Donovan, 1890 C.D. 109, 52 O.G. 309 (Comm'r
Pat. 1890) the court stated

> If the applicant made sketches he should so state, and produce and describe them;
> if the sketches were made and lost, and their contents remembered, they should be
> reproduced and furnished in place of the originals. The same course should be
> pursued if the disclosure was by means of models. If neither sketches nor models
> are relied upon, but it is claimed that verbal disclosures, sufficiently clear to
> indicate definite conception of the invention, were made the witness should state
> as nearly as possible the language used in imparting knowledge of the invention
> to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must
consider all of the evidence presented in its entirety, including the affidavits or
declarations and all accompanying exhibits, records and "notes." An accompanying
exhibit need not support all claimed limitations, provided that any missing limitation is
supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat.
App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data
applicant is relying on to show completion of his or her invention prior to the particular
date. Vague and general statements in broad terms about what the exhibits describe along
with a general assertion that the exhibits describe a reduction to practice "amounts
essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does
not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184
USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing
out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184
USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964)
(Affidavit "asserts that facts exist but does not tell what they are or when they
occurred.").

Declaration of Alan B. Conley and Robert C. Allen – Paragraph 3:

We make this declaration for the purpose of establishing that a functioning version of a

computer program that embodies an invention disclosed and claimed in the above-referenced

application (hereinafter "the subject invention") was created in the United States at a date prior

to January 5, 2001, which is the filing date o Kaan, and prior to October 2, 2002, which is the

provisional parent application 60/237, 211 to which KAAN claims priority.

Declaration of Alan B. Conley and Robert C. Allen – Paragraph 5:

We, Alan B. Conley, then serving as MEMBER OF TECHNICAL STAFF, and Robert C. Allen,

then serving as. IT ENGINEER, were on the team that developed the "repl-gen" program, which

is an enterprise management tool which, generally, parses router configuration files and

determines the proper replication topology to inject into a directory service environment. As

established by the attached documentary exhibits, "repl-gen" was a functioning version of a

computer program that embodies the subject invention.

Declaration of Alan B. Conley and Robert C. Allen – Paragraph 6:

Attached, as Exhibit 1, is a true and correct redacted copy of the contents of an electronic mail

from Robert Allen, which includes output from a functioning version of "repl-gen", which

embodies the inventive features described and claimed in the application. The date of this

document is redacted, but the true date is long prior to October 2, 2000. The test that produced

the output was executed under typical working conditions and shows utility beyond probability

of failure. We found that the minor errors that were present in the output were readily overcome

without significant effort or experimentation. This e-mail document is maintained on a server

operated by Cisco Systems, Inc., an affiliated corporation of Cisco Technology, Inc., the

assignee of the present application; and is hereby submitted as probative of a reduction to

practice of the subject invention prior to October 2, 2000.

Declaration of Alan B. Conley and Robert C. Allen – Paragraph 7:

Attached, as Exhibit 2, is a true and correct redacted copy of the contents of an electronic mail

from Alan Conley, which describes functionality for managing Active Directory replication

topology, which embodies the subject invention described and claimed in the application. This

document includes descriptions of processing router configuration files and pre-processing

information, and an extensive textual description of an algorithm that is embodied in the "repl-

gen" program. This document was created substantially concurrently with the version of the

"repl-gen" program that produced the output illustrated in Exhibit 1. The date of this document is

redacted, but is long prior to October 2, 2000. This e-mail document is maintained on a server

operated by Cisco Systems, Inc., an affiliated corporation of Cisco Technology, Inc., the

assignee of the present application; and is hereby submitted as probative of a reduction of

practice of the subject invention prior to October 2, 2000.

Examiner's Assessment:

Applicant has not complied with the formal requirements of 37 CFR 1.131 as outlined

above. In particular, applicant has not addressed conception of the invention nor diligence in

reduction to practice.

Applicant's statements regarding dates are ambiguous. Applicant states the following:

- the date of this document [Exhibit 1] is redacted, but the true date is long prior to October
  2, 2000.

- the date of this document [Exhibit 2] is redacted, but is long prior to October 2, 2000

- a reduction to practice of subject invention prior to October 2, 2000.

No dates are presented in Exhibits 1 and 2. Dates argued by applicant are the filing date of the

nonprovisional application and the filing date of the provisional application of Kaan [Pub. No.

2002/0065941]. Regarding Exhibit 1, the "true date" mentioned by the inventors is unclear.

Does this imply that other dates may be false. Furthermore, it is unclear to what this "true date"

pertains, i.e., conception and/or reduction to practice.

Applicants give no indication when they started working on the present invention and

therefore, applicants appear to be able to claim any date for conception and reduction to practice.

Because applicant has not proven a conception date and diligence in reduction to practice of the

present invention, the 37 CFR 1.131. affidavit has not obviated the 35 U.S.C. 102(e) rejection as

being anticipated by Kaan.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

1/7/2004

SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100